

## **REMARKS**

This paper is filed in response to the Office Action dated August 27, 2003. As this paper is filed on December 29, 2003 with a one-month petition for extension of time, the paper is timely filed (December 27 being a Saturday, and December 28 being a Sunday).

### **I. Status of Amendments**

Claims 1-90 were pending prior to this amendment. By this amendment, applicants cancel claims 1-90 without prejudice to refile, and add claims 91-122. Thus, claims 91-122 are now pending.

Because applicants previously paid fees for 4 independent and 90 total claims, applicants' amendments do not require a further fee to be paid.

### **II. Response to Office Action**

#### **A General Comments**

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the

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<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

term “invention” may be used to refer to subject matter which is nonobvious; and the term “invention” may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term “invention” in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence “As used herein, the term ‘\_\_\_\_\_’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

**B. The August 27 Office Action**

In the August 27 Office Action, objections were raised to the drawings. It is believed that these objections were made as to the informal drawings originally filed, although applicants later filed corrected, formal drawings on February 1, 2002. A copy of the February 1 submission has been included herewith as an attachment. In any event, applicants submit herewith copies of the formal drawings submitted on February 1 as replacement sheets. In regard to the objections, applicants note that the first replacement sheet shows the entire text in boxes 155 and 162, which text was partially cut off (but fully identifiable) in the originally-filed, informal drawings. However, applicants respectfully disagree with the suggestion that the accounting networks 164 and 170 are duplicative, because the network 164 is "ACCOUNTING RS-232," while the network 170 is "ACCOUNTING NETWORK RS-485." Therefore, no amendments have been made in regard to networks 164 and 170.

Further, the specification was objected to, with several minor typographical errors being noted. Applicants have amended the specification to correct the noted typographical errors, as well as other typographical errors noted upon further review. Applicants submit that the amendments add no new matter to the specification.

Finally, claims 1-6, 11, 18, 19, 21, 27, 29, 31, 32, 34-37, 43, 49-51, 53-55, 59-63, 70, 71, 73, 74, 76, 80, 81, and 83-85 were rejected under 35 U.S.C. 102(b) as allegedly anticipated by Nagao et al. (U.S. Patent No. 5,645,486), and claims 7, 11-13, 16, 17, 20, 22-26, 28, 30, 33, 38, 44-48, 52, 58, 64-69, 72, 75, 77-79, 82 and 86-90 were rejected under 35 U.S.C. 103 as allegedly unpatentable over Nagao et al. in view of DeFrees-Parrott et al. (U.S. Publ. Appln. 2001/0036855). Applicants have cancelled claims 1-90, thus mooting the rejections. However, applicants have the following comments regarding Nagao et al. and DeFrees-Parrott.

As an initial matter, in regard to the statements made previously by applicant and the examiner that the winning probability of the allegedly corresponding "lottery" of Nagao et al. corresponds to the amount of coins that a player has bet (see, paragraph [0005] of the specification, and the August 27 Office Action at 3), Nagao et al. also states (at col. 12:26-29): "However, it is possible to set the probability that is not always proportional to the bet amount. For example, the probability may be selected randomly or on the basis of some factor (e.g. time of day)."

Claim 91 recites a gaming method including receiving a wager from a player, displaying an image associated with a primary game, determining an outcome of the primary game, and determining if a qualifying activity associated with the primary game has occurred. The method also includes associating at least one entry for a shared bonus event with a gaming entity if the qualifying activity associated with the primary game has occurred, and permitting the player to place the at least one entry with one of a set of entries for a first shared bonus event and a set of entries for a second shared bonus event. The method further includes selecting one of the entries from the set of entries for a first shared bonus event, determining a winner of the first shared bonus event according to the one of the entries selected, selecting one of the entries from the set of entries for a second shared bonus event, and determining a winner of the second shared bonus event according to the one of the entries selected.

In regard to the allegedly corresponding “lottery” identified in the August 27 Office Action, Nagao et al. states (col. 10:1-13):

Meanwhile, if the winning combination is a ROYAL FLUSH at step 8, it is judged whether or not the bet amount is the predetermined maximum value (STEP S9). . . . If the player doesn’t bet the maximum amount, a lottery is performed (STEP S10).

Further, Nagao et al. states (col. 11:34-54):

In FIG. 16, the lottery indicating section i includes lines for indicating 5 to 1 BETs from top to bottom. Five circles 0 are arranged in the 5 BET line, four circles 0 are arranged in the 4 BET line, three circles 0 are arranged in the 3 BET line, two circles 0 are arranged in the 2 BET line, and one circle 0 is arranged in the 1 BET line. . . . the lengthwise lottery determining frame k moves from left to right, i.e., from the first row to the fifth row, enclosing circles, and stops after the fixed time. If there is a circle at the place where the row determined bet indicating frame j and the lottery determining frame k which has stopped, the player wins. The player loses if there is no circle at that place.

Thus, according to Nagao et al., there is no “permitting the player to place the at least one entry with one of a set of entries for a first shared bonus event and a set of entries for a second shared bonus event,” but the allegedly corresponding “lottery” involving the allegedly corresponding “entry” is carried out as a direct consequence of the player meeting the requirements for participating in the lottery.

Similar to the “lottery” of Nagao et al., DeFrees-Parrott et al. states, for example, at paragraph [0030]:

In one embodiment, the lottery game is configured as a Quick Pick lottery and the Quick Pick numbers are erased after each play and replaced with new quick pick numbers or a players chosen numbers.

As to other embodiments, DeFrees-Parrott et al. states, for example, at paragraphs [0073] and [0074]:

Next, lottery game device 10 generates a lottery ticket having the player's selected lottery number. In alternative embodiment, the player's identification card has the player's favorite lottery numbers encoded thereon. . . . Data representing the winning lottery number is then generated by the central lottery computer and inputted into interface connector 60. Control module 40 then controls lottery game display 36 to display the winning lottery numbers. If the player is a winner, control module 40 then outputs a signal to lottery game display 36 and visual and audio module 38 to provide video and audio information that informs the player he or she is a winner.

Additional examples may be provided, but it is believed that none of the embodiments of DeFrees-Parrott et al. include each and every limitation of the subject matter of claim 91, for example, "permitting the player to place the at least one entry with one of a set of entries for a first shared bonus event and a set of entries for a second shared bonus event."

Given that claims 92-122 depend from claim 91 and that claim 91 is distinguishable from Nagao et al. and DeFrees-Parrott, so too are claims 92-122.

Therefore, in view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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